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KEIL & WEINKAUF
1101 CONNECTICUT AVENUE, NW
WASHINGTON, DC 20036

In re Application of :
Matthias Witschel et al :
Serial No.: 09/936,356 : PETITION DECISION
Filed: September 11, 2001 :
Attorney Docket No.: 49828 :

This is in response to the petition under 37 CFR 1.144, filed June 10, 2005, requesting withdrawal of an improper restriction requirement.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 371 and accepted on September 11, 2001, and, as amended, contained claims 1-21. In a first Office action, mailed January 17, 2003, the examiner set forth a Lack of Unity requirement dividing the claims into at least 13 groups, as follows:

Group I – claims 1-7 and 14-17, drawn to products of formula I, where X=O and Y forms a pyridine;

Group II – claims 1-6, 8 and 12-17, drawn to products of formula I, where X=C and Y forms a pyrazole;

Group III - claims 1-6, 9 and 14-17, drawn to products of formula I, where X=S and Y forms an oxazole;

Group IV - claims 1-6, 10 and 14-17, drawn to products of formula I, where X= a bond and Y forms a thiazole;

Group V - claims 1-6, 11 and 14-17, drawn to products of formula I, where X=O and Y forms a pyrazine;

Group VI - claim 18, drawn to products of formula VI, where X=S and Y forms a pyridine;

Group VII - claim 18, drawn to products of formula VI, where X=O and Y forms a pyrazole;

Group VIII - claim 19, drawn to products of formula IX, where X=O and Y forms an oxazole;

Group IX - claim 19, drawn to products of formula VI, where X=S and Y forms a thiazole;

Group X - claim 20, drawn to products of formula XV, where X= C and Y forms a pyrazine;

Group XI - claim 20, drawn to products of formula XV, where X= a bond and Y forms a pyridine;

Group XII - claim 21, drawn to products of formula XVI, where X=O and Y forms a pyridine;

Group XIII - claim 21, drawn to products of formula XVI, where X=S and Y forms a pyrazole;

The examiner required applicants to elect a single invention as set forth in the enumerated groups or to identify another specific embodiment to which the claims would be restricted. The examiner stated that the groups lack a common special technical feature since the base tricyclic compounds vary in structure and ring atoms (i.e. Y forms one of the tricycle, rings as does X)

On February 10, 2003, applicants replied by amending the claims, canceling claim 17 and adding claims 22-23 and then elected the compounds identified in claim 22 and a species therewithin. The elected compounds did not fall within any of the above enumerated groups. Applicants traversed the holding on the basis that the special technical feature is not required to define over the prior art.

The examiner mailed a new Office action to applicants on December 31, 2003, maintaining the Lack of Unity requirement and replying to applicants' traversal by maintaining that the common special technical features argued by applicants are to significantly different compounds. The requirement was made Final. The examiner also rejected claims 1-6, 8, 12, 14-16 and 22-23 under 35 U.S.C. 103(a) as unpatentable over Tseng et al.

Applicants replied on June 30, 2004, canceling claims 2-4 and 22 and amending claims 1, 5, 11 and 23, again traversing the Lack of Unity requirement and arguing the rejection of record.

The examiner mailed a Final Office action to applicants on February 16, 2005, noting that applicants have amended the claims to include only the elected group, but continued the traversal with respect to intermediate compound claims 18-21. The examiner replied and maintained the finality of the holding. The examiner then rejected claims 1-6, 8, 12, 14-16 and 22-23 (sic 1, 5-6, 8, 12, 14-16 and 23) under 35 U.S.C. 103(a) as unpatentable over Tseng et al, as before., and made the action Final.

Applicants filed this petition and a reply to the Office action on June 10, 2005. A Notice of Appeal was filed on June 16, 2005.

DISCUSSION

Applicants first argue that the initial Lack of Unity holding is in error because the PCT Rules and guidelines do not require that the special technical feature define a contribution over the art and that the reference relied on by the examiner fails to show the special technical feature which applicants rely on. Applicants state that the claims relate to compounds and intermediates for their preparation and rely on the tricyclic structure of a benzene ring fused to a five member

unsaturated ring which is fused to a variable sized ring which may be heterocyclic and saturated or unsaturated. Applicants also argue that the structures of formulas XVI, XV, IX and VI are intermediates to the final product, but all contain the tricyclic structure. Applicants request that the claims as presently pending be considered to have Unity and that withdrawn claims 18-21, drawn to intermediates be rejoined for examination purposes.

As applicants request review with respect to only presently pending claims which have been amended to a limited structure, review with respect to the original requirement as pertaining to other Groups, the claims to which have been canceled, will not be made.

A review of the pending claims shows that claims 1, 5 and 6 are directed to a benzopyrazole structure of formula I where X is a bond and Y forms an oxazole ring. Claims 7-13 are to various processes of preparing the compound of claim 1 using various precursors reacted with a tricyclic benzoic acid. Claim 14 is to the composition as a herbicide and claim 15 to the herbicide preparation and claim 16 to controlling unwanted vegetation with the herbicide. Withdrawn claims 18-21 are to tricyclic benzoic acid or benzene or cyano or aniline precursors all of which contain the tricyclic structure of claim 1 on which Unity for all other claims is based. These structures lack only R⁹ which is the pyrazole bonded to the basic tricyclic structure in the place of the acid, cyano or amino function. As the examiner based the original Lack of Unity requirement on the tricyclic structure and not on variable R⁹, the intermediate compounds are found to contain all of the requirements set forth by the examiner for the special technical feature on which Unity was based. These claims, under PCT Rules and guidelines, are to be examined with the product claims since the intermediate contains all of the special technical features of the final product.

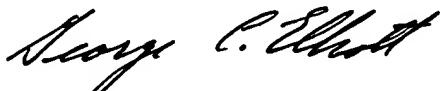
DECISION

The petition is **GRANTED**.

The application will be forwarded to the examiner for consideration of all claims pending including withdrawn claims 18-21.

In view of the above decision, the Finality of the last Office action is withdrawn as the Office action is incomplete. Therefor, applicants' Notice of Appeal is premature and is held in abeyance until a proper Final Office action ensues and applicants choose to pursue a proper Appeal. A new Notice of Appeal will not require a fee unless applicants, in view of the above decision, request refund of the Appeal Fee paid.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 703-308-3824 or by facsimile sent to the general Office facsimile number, 571-273-8300



George C. Elliott
Director, Technology Center 1600